

Appl. No.: 10/612,718
Amdt. Dated: 12/21/2004
Off. Act. Dated: 07/29/2004

REMARKS/ARGUMENTS

Applicant has carefully considered all of the Examiner's comments. No claims have been allowed. Claims 1-16 are pending. Claims 1-8 and 11-17 are rejected. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The Examiner has examined all claims 1-16, for which Applicant is very grateful.

Claims 1, 7, and 10 have been amended. Claims 6 and 9 have been cancelled. No new claims have been added. Applicant has rewritten Claim 1 to include all the limitations of Claims 9 and 10, therefore, Claims 2-5, 7-8, and 10-13 should be allowable at this time as being based upon an allowable Claim 1.

Applicant responds to all of the Examiner's issues below. With this amendment of the claims, it is believed that all claims are in a condition for allowance and Applicant respectfully requests reconsideration of this application in view of the amendments and discussions presented below.

1. 35 U.S.C. 112 Second Paragraph Rejections.

The Examiner has rejected claims 2-5; 7, 11, 12, and 16 under 35 U.S.C. 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner continues to point out multiple occurrences of the usage of the word "or" in Applicant's claims as a basis for rejection of the claims. Applicant respectfully traverses the rejections, and requests reconsideration.

MPEP 2173.05(h) particularly points out that the usage of "or" in claims is now acceptable USPTO practice and not in violation of 35 U.S.C. 112, second paragraph. The quoted passage follows below:

**MPEP 2173.05(h) Alternative Limitations
II. "OR" TERMINOLOGY**

Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph

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in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975):
"made entirely or in part of"; "at least one piece"; and "iron, steel or
any other magnetic material."

As the MPEP section cited above specifically permits such usage of the word "or" in claims, Applicant respectfully requests withdrawal of the rejections and reconsideration.

2. 35 U.S.C. 102 Claim Rejections.

Claims 1-8, 11, and 14-15 stand rejected under 35 U.S.C. 102(b), as being anticipated by Seils (U.S. Patent No. 1,706,634).

Claims 1-3, 11, and 14-15 stand rejected under 35 U.S.C. 102(b), as being anticipated by Moore (U.S. Patent No. 3,063,752).

Claims 1-3, 11, and 13-14 stand rejected under 35 U.S.C. 102(b), as being anticipated by Miller (U.S. Patent No. 4,069,995).

Claims 1-8 and 14-15 stand rejected under 35 U.S.C. 102(b), as being anticipated by Holstensson (U.S. Patent No. 5,571,274).

Claims 1-8, 11-12, and 14-15 stand rejected under 35 U.S.C. 102(b), as being anticipated by Nakamura et al. (U.S. Patent No. 5,927,815).

Claims 1-8 and 14-15 stand rejected under 35 U.S.C. 102(b), as being anticipated by Hong (U.S. Patent No. 6,042,064).

Claims 1-8, 11, and 13-15 stand rejected under 35 U.S.C. 102(e), as being anticipated by Bouhuijs (U.S. Patent No. 6,464,183).

At this time, Applicant reserves the right to argue the specific rejections above at a later date should such argument be needed. However, the claims have been rewritten to obviate such arguments at this time. Applicant respectfully traverses the rejections as applied to Claims 1-5, 7-8, and 10-13, and requests reconsideration in light of the amended claims.

Applicant does, however, specifically wishes to argue the various 35 U.S.C. 102 rejections of Claims 14-15. Applicant respectfully traverses the rejections of Claims 14-

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15, and requests reconsideration. At no point in Examiner's arguments was the specific means-plus-function language of Claim 14 discussed. For convenience, Claim 14 reads as follows, with means plus function language bolded:

14. An ergonomic arm support apparatus comprising:
(a) an armrest having a topside and an underside;
(b) **means connected to the armrest for providing a continuous counterbalancing compliant upward force to said armrest to dynamically support a forearm resting on the armrest in an equipoise position.**

A simple argument responding to the Examiner's rejections to Claims 14-15 is that, since allowable matter was found in the specification despite all of the prior art that the Examiner was able to bring to bear, then a means plus function claim covering such invention described in the specification should also be patentable. If the Examiner is inadvertently reading the claims in broad language without regard to the specification, this practice is not allowed under *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

Regarding means plus function interpretation, the MPEP, version 8, revision 2, states at page 2100-9:

Where means plus function language is used to define the characteristics of a machine or manufacture invention, claim limitations must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof." (Two en banc decisions of the Federal Circuit have made clear that the Office is to interpret means plus function language according to 35 U.S.C. 112, sixth paragraph. In the first, *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the court held:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be. Thus, this court must accept the plain and precise language of paragraph six.

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Thus, the Examiner must look to the specification to construe the means-plus-function language of the claim. Since the specification recites allowable matter as exemplified by the objected to Claims 9 and 10, now rewritten as Claims 1-5, 7-8, and 10-13, then the means-plus-function claim covering the same matter should also be allowable.

The Examiner is therefore requested to reconsider the rejections of claims 14-15, and to kindly withdraw the rejections on this basis.

3. **Additional Claim Fees.**

There are no new claims, therefore, there should be no additional claim. Applicant is a small entity.

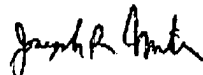
4. **Conclusion.**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and objections of the claims and to pass this application to issue.

The Applicant also respectfully requests a telephone interview with the Examiner in the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims.

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Respectfully submitted,



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